

bottom base member and a said rear bottom base member". Antecedent basis for this is found at the top of Pg. 5.

Claim 15 is cancelled with this amendment.

Claim 9 is amended to change the "first assembly" and "second assembly" to "front assembly" and "rear assembly" to correct antecedence with claim 1.

## **CLAIM REJECTIONS UNDER 35 USC 102**

Claims 1 and 22 are rejected over the reference to Shumate, who discloses a carrier having transverse feet 17, 17' that rest in the bed of a pickup truck (Col. 1 lines 65-67). The structure is held in place in the bed of the truck only by straps that attach to sides of the truck bed (Col. 2 lines 56-61), and not a "platform site". It is noted that the most appropriate definition of a "platform", as defined in THE RANDOM HOUSE DICTIONARY OF THE ENGLISH LANGUAGE, SECOND EDITION UNABRIDGED, Random House inc. NY.NY. copyright 1987, defines "platform" as "a horizontal surface or structure with a horizontal surface raised above the level of the surrounding area". Thus, a pickup truck bed cannot be said to have a "front platform site" as the bed is lower than the adjacent sides, while it is perfectly appropriate to call the racks at the front and rear of an ATV "platform sites" as they are raised above the adjacent fenders. Please see Applicant's Fig. 2.

Applicant's claim 1 provides a vehicle "having available a front platform site extending generally across a width of a front of said vehicle". The

reference to Shumate only is concerned with a truck bed that is not a "platform site" and is behind the cab and behind the driver, both of which in turn being behind the front of the vehicle, which extends in front of both. Also, there is no teaching or showing in Shumate that his pickup truck bed extends "generally across a width of a front of said vehicle...". In fact, most pickup truck beds are narrower than a front of the truck because of fenders and other components associated with the front of the truck. Also, the transverse feet 17 of Shumate either extend only a short distance with respect to the width within the truck bed (Fig. 2), or since the relationship between length of the feet across the truck bed and the width of the truck bed is not shown, width of the feet with respect to width of the truck bed is indeterminate. Further, as the rack of Shumate is entirely in the truck bed, whih is noted is behind the cab, there is no relationship whatsoever with his rack and the width of the front of the truck.

Applicant also claims "a front assembly having a front bottom base member attachable to said front platform site and across a width of said front platform site and a rear assembly having a rear bottom base member attachable to said rear platform site and across a width of said rear platform site...". These underlined features of Applicant's claim 1 are not taught, suggested or inferred in the reference to Shumate, as there is no attachment disclosed between feet 17 and the bed of his truck. Please see MPEP 2131, "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference"

and “The identical invention must be shown in as complete detail as is contained in the ... claim”. As such, it is respectfully submitted the rejection to claim 1 over the reference to Shumate is untenable under 35 USC102, and should be withdrawn.

Applicant’s claim 22 provides ”mounting a first single vertical support so that said first single vertical support extends upward over a middle of a front of said vehicle, said middle being with respect to width of said vehicle,” and ”mounting a second single vertical support...”. As noted above, there is no “mounting” of either of the vertical posts in Shumate, they merely rest in the bed of the truck. Mounting of the rack of Shumante is achieved by straps attached between upper transverse bars and sides of the truck. In addition, the front vertical support of Shumate is not mounted “over a middle of a front of said vehicle”, as claimed by Applicant. Rather, his rack is mounted in a bed of a truck behind the cab and driver, which are both behind the front of the vehicle (Fig. 1). It is noted that the most appropriate definition of “mount” in the above-referenced dictionary is “to attach to or fix on or in a support, backing, setting, etc.: *to mount a photograph; to mount a diamond in a ring.*

For reasons set forth with respect to claim 1, it is respectfully submitted the rejection to claim 22 over the reference to Shumate is untenable under 35 USC 102, and should be withdrawn.

## **FACTUAL ERRORS RELATED TO THE 102 REJECTION**

Errors with respect to the above 102 rejection are as follows:

With respect to Applicant's claim 1, the Office states:

"Shumate discloses an accessory rack 10... with a front assembly having an elongated front bottom base member 17 attachable across the width of the front platform site and a rear assembly having an elongated rear bottom base member 17' attachable across the width of the rear platform site.". This is incorrect in that Shumate does not disclose that either of the bottom members are "attachable" or "across the width of the front or rear platform sites. In fact, with respect to width, Fig. 2 of Shumate teaches to the contrary.

The Office states:

"A single front upright post is connected...so it is generally centered with respect to the vehicle...". This is incorrect; there is no teaching or showing in Shumate whatsoever that his front upright post is "generally centered with respect to the vehicle". The same is true for the rear upright post. In fact, since positioning of the rack, and front and rear vertical posts thereof, of Shumate is entirely dependent on adjustment of straps (Col. 1 lines 63-65, Col. 2 lines 65-67) and not a fixed attachment to a "platform site", the vertical posts of Shumate may be located anywhere across the width of the truck bed.

The Office states:

"A single elongated upper beam member 13 extends between the front and rear boat-receiving cross members... so that the front and rear upright posts and the upper beam members are centered over respective portions of the vehicle (figures 1-3). This is incorrect; as noted, the use of adjustable straps and lack of an attachment to a "platform site" does not fix the front and rear

upright posts and upper beam members “centered over respective portions of the vehicle”. “Centered over respective portions of the vehicle” is also not shown in Figs. 1-3 of Shumate, as asserted by the Office.

With respect to claim 22, the Office states:

“With respect to claim 22, use of the rack of Shumate discloses this method”. This appears to be an omnibus rejection that contains no legal basis for the rejection. Please see MPEP 707.07(d). However, it is noted that claim 22 provides “mounting a first single vertical support so that said first single vertical support extends upward over a middle of a front of said vehicle...” (emphasis added). This provision is not seen in Shumate for reasons noted with respect to claim 1. It is also noted that Applicant’s first and second supports are “mounted”, and thus fixed in place in a specific orientation “over a middle” of the vehicle, while the vertical supports of Shumante are not fixed in place at all in any specific orientation.

### **CLAIM REJECTIONS UNDER 35 USC 103**

Claims 1-4, 9-15 and 17-20 are rejected over the primary reference to Armstrong in view of Oliver. The reference to Armstrong teaches a utility rack system consisting of a pair of single, separate support racks that each includes an adjustable upper T-shaped load support. Each rack is held in place by a first clevis-type bracket and pin between the bed of a pickup truck and a lower end of the rack, and a second clevis-type bracket and pin between a wall of the truck and the middle of the rack. As shown in Fig. 4, the second bracket may

be disconnected so that the racks may be disposed in a stowed position in the bed of the truck. The reference to Oliver teaches a boat-loading apparatus wherein a first, rearward part of the boat rack is mounted to the top of a utility vehicle, and a second part of the rack is mounted to a front bumper of the vehicle. A connecting member connects the first and second parts of the rack over the middle of the vehicle.

The reasoning the Office asserts as to why it would have been obvious to combine Armstrong and Oliver states "It would have been obvious to one of ordinary skill in the art at the time of invention to include a single, elongated upper beam between the front and rear assemblies of Armstrong, in order to give strength to the accessory rack when it is in a working position.". However, this reasoning is in error. Initially, the Office fails to identify a suggestion for combining Oliver with Armstrong. Here, Applicant reminds the Office of the legal principles for rejecting a claim under 35 USC 103. The Federal Circuit, in *re In Rouffet*, 47 USPQ 2d 1453 (Fed Cir 1998) stated:

"To reject claims in an application under section 103, an Examiner must show an unrebutted *prima facie* case of obviousness. In the absence of a proper *prima facie* case of obviousness, an applicant who complies with the other statutory requirements is entitled to a patent."(Id. At 1455, citations omitted and emphasis added).

In Rouffet, the claims were rejected over a combination of references, and the rejection was sustained by the Board. Upon appeal, the Federal Circuit reversed the decision of the Board and ruled the Examiner's rejections were

legally impermissible because they failed to demonstrate a suggestion for combining the references. The Court stated:

“virtually all [inventions] are combinations of old elements”. Therefore, an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be “an illogical and inappropriate process by which to determine patentability”. To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness.”

Id. at 1457-58 (citations omitted). These principles have not been followed in rejecting claim 1. Merely stating a possible advantage of combining references, as was done to reject claim 1, is not the same as “show[ing] a motivation to combine the references”. More recently, in *KSR Int'l v Teleflex Inc.*, 127 S. Ct. 1727, 1740-41, 82 USPQ2d 1385, 1396 (2007), the Supreme Court cited with approval *In re Kahn*, (citations omitted) stating:

“Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness” (*In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006)).

and also

“a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements lies, independently, known in the prior art”.

Further yet, in the unpublished Board decision, Ex Parte Megens, App. No. 1999-0277 (BAPI Oct. 29, 1999), the Board stated:

“Rejections based on 35 USC 103 must rest on a factual basis. *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 177-78 (CCPA 1967). In making such a rejection, an examiner has the initial duty of supplying the requisite factual basis and may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. Id.

The examiner’s conclusion that it would have been obvious to incline Phillips’ loading dock floor 65 rests on the completely unfounded assumption that it would be desirable to drain liquid from the floor. The Phillips reference, however, is devoid of any indication that liquid might accumulate on the floor or that such accumulation would pose a problem even if it did occur. It is therefore apparent that the examiner has resorted to improper speculation and hindsight reconstruction to overcome the admitted deficiency of Philips vis-à-vis the subject matter recited in claim 1

(Megens at pages 4-5)

This is analogous to the situation at hand. Here, the “suggestion”

used to support the rejection of claim 1 amounts to nothing more than a speculative statement that, given the alleged presence of the claim elements in the prior art and an advantage that combining these elements would achieve, a person of ordinary skill in the art would have found it obvious to combine the references to create the claimed invention. However, the problem with this approach is that it effectively eliminates the requirement of identifying a suggestion for combining references. More specifically, the analysis of the Office is as follows:

- a) What elements are present in the pending claims?
- b) Can these elements be found in prior art references?
- c) If they can be found, and the references themselves provide no suggestion for combining these elements, can some end or advantage be identified to combine the elements in the manner proposed by Applicant?
- d) If so, combine the elements in the manner proposed by Applicant and reject the claims.

This mode of analysis is obviously flawed. Specifically, as noted by the Federal Circuit in Rouffet, all of the elements of most claimed inventions can almost always be found in the prior art. Thus, the answer to step ‘b’ above will always be yes. Since it is a statutory requirement that all inventions have utility, there will always be an identifiable end or advantage and combining the prior art elements proposed by any claim. Therefore, if the “suggestion” requirement can be met merely by identifying any end or advantage which will be achieved by combining the elements of the prior art references, the

suggestion requirement can always been met and is utterly meaningless.

This flaw in the analysis in rejecting claim 1 may be elucidated by viewing the “suggestion” set forth by the Office in support of the rejection. As noted, the Office states “it would have been obvious to one of ordinary skill in the art at the time of invention...” is mere boilerplate language that does not address the suggestion requirement. The second part of the statement, “to include a single elongated upper beam between the front and rear assemblies of Armstrong...” simply states with the proposed modification of the primary reference is to be. The last part of the statement, “in order to give strength to the accessory rack when it is in a working position..” must then be the alleged “motivation” for modifying Armstrong. However, this statement does not identify any evidence suggesting desirability of the proposed modification. It only identifies an old element that has an inherent property. This conclusory statement amounts to nothing more than “the person of ordinary skill in the art would be motivated to modify Armstrong to include the upper beam because they would want to gain a benefit from having the upper beam.” Such circular reasoning (add X to have X) is not a legally proper tool for identifying the suggestion for providing references. If it were, no combination of old elements would ever be patentable since one can always state, in a conclusory matter, a person would be motivated to add old element X from one reference to another reference because adding element X offers an advantage. Simply put, there is always an advantage to combining old elements that can be identified through hindsight once the combination is known.

MPEP 2144 II further buttresses this point, stating “the strongest rationale for combining references is a recognition...in the prior art or...based on established scientific principles or legal precedent, that some advantage would have been produced by the combination. In re Sernaker is cited in support. The Federal Circuit stated in Sernaker, ”the lesson of this case appears to be that prior art references and combination do not make an invention obvious unless something in the prior art to references would suggest the advantage to be derived from combining their teachings.”. This statement does not state that it is obvious to combine references simply because there is an advantage to doing so. To the contrary, the court carefully states that there can be no obviousness ruling unless something in the art suggests an advantage to combining the references. The advantage itself is not the suggestion; rather, something else must suggest the advantage.

With respect to the rejection of claim 1, rather than identifying something in the art that suggests an advantage to making the combination, the Office simply looks for the advantage itself and mislabels that advantage as a “suggestion”. This is literal elimination of the suggestion requirement. Since there is always an advantage to a claimed element, the Office’s misplaced view of an advantage as the suggestion inherently renders all combinations of old elements unpatentable precisely because it eliminates the suggestion requirement from the analysis.

Is respectfully submitted there is no suggestion or motivation to combine the references as proposed by the Office. Here, the pair of racks of

Armstrong are already sufficiently strong so as to function as intended without a connecting bar between them. Thus, there is no problem to be solved by the addition of the beam of Oliver, and thus there cannot be a suggestion, motivation or need for the modification proposed by the Office. Simply piecing a catalog of prior art elements together in accordance with Applicant's claims does not suffice as a "suggestion or motivation" ("[A] patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.", *KSR Int'l Co v. Teleflex, Inc.*, 127 S. Ct. 1727, 1741, 82 USPQ2d 1385 (2007)). Further, since the racks of Armstrong are sufficiently strong as they are, it is apparent that the Office has used improper hindsight reconstruction using Applicant's disclosure as a guide to assemble the prior art elements (MPEP 2143, "impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art."). In addition, were the racks of Armstrong modified as suggested by the Office, they would not be foldable as shown in Fig. 4 to a stowed position in the bed of a truck, which is included in the intended use of Armstrong. Thus, the proposed combination would make Armstrong inoperable for its intended purpose (MPEP 2143.01 V, "If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification). Further, the racks of Armstrong are designed so that strength for support is derived from brackets attached to walls of a truck bed, and easily removed therefrom by pins. To insert a bar between the racks would

also change its principle of operation (MPEP 2143.01, If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious").

For at least these reasons set forth in the foregoing, it should be apparent that a *prima facie* case for obviousness has not been made and the rejection to claim 1 should be withdrawn.

Applicant's claim 9 provides the composite invention of claims 1 and 2, and adds the feature of "a stub portion attached to said center of said middle portion, and facing an opposite one of said first assembly and said second assembly for removably and slidably receiving and locking to said upper beam member...". This claimed structure provides a stub shaft at the center of each of Applicant's cross members, with an adjustable beam connected to each of the stub shafts. This structure is not found in any combination of Armstrong and Oliver, as Oliver only has a single stub shaft at the front of his rack. The rear of his rack is provided with a sleeve for adjustably receiving the beam (Col. 3 lines 9-18). Also with respect to claim 9, there is no suggestion or motivation to combine Armstrong using the structure of Oliver, as the racks of Armstrong cannot be adjusted. Rather, the length between the racks is set by the distance between the front and rear sides of the bed of the truck. Thus, as the purpose of the adjustments of Oliver are to adjust the length of the rack to fit the vehicle (paragraph bridging Cols. 2 and 3) there is no problem in Armstrong to be solved by the structure of Oliver. Also, to insert a beam between the

racks of Armstrong, as noted above, would change the principle of operation and make his racks inoperable for their intended purpose as they could not be folded to the stowed position.

For at least the reasons set forth above, a *prima facie* case for obviousness has not been made with respect to claim 9, and the rejection should be withdrawn.

Independent claim 17 is rejected over Armstrong in view of Oliver, the Office using the same circular logic enumerated with respect to claim 1 in order to mislabel an advantage as a “suggestion”. However, it is noted that claim 17 provides a rack mountable to a cargo rack over a front of a vehicle and to a rear cargo rack over a rear of a vehicle, and mounting means for removably mounting the front end assembly and rear end assembly to respective cargo racks. As the “mounting means” are means-plus-function limitations, they should be construed under 35 USC 112, paragraph 6. As such, the front and rear mounting means can only be construed as being the corresponding structure in the specification and its equivalents. Applicant uses U-bolts to rigidly attach his front and rear assemblies to corresponding racks over the front and rear of the vehicle. In contrast, Armstrong uses a clevis-type bracket and pin extending through both the upright member and bracket to a bed and walls of a pickup truck so that the racks are pivotable, which is not an equivalent to a U-bolt attached to a rack as the structure, function and result are different.

Applicant’s claim 17 further provides that each of the front and rear

assemblies comprises “a single, adjustable-in-height vertical support means attached to said mounting means so that said single, adjustable-in-height vertical support means is generally centered widthwise with respect to said cargo rack, and thereby over a middle of a respective front or rear of said vehicle”. As this limitation is a means-plus-function limitation, it should be construed under 35 USC 112, sixth paragraph as being limited to the corresponding structure disclosed in the specification and its equivalents. As there is no corresponding front cargo rack at the front of the vehicle of Armstrong, Applicant’s support means cannot be mounted over a middle of a respective front of said vehicle.

Applicant’s claim 17 also provides “connection means connected between said center of said elongated horizontal support means of said front end assembly and said center of said elongated horizontal support means of said rear end assembly, and extending lengthwise over a middle of said vehicle, for connecting said front end assembly and said rear end assembly together”. This is a means-plus-function limitation that should be construed under 35 USC 112, sixth paragraph, and as such, is limited to the corresponding structure in the specification and its equivalents. As noted above, the racks of Armstrong operate by being attached to sides of a truck separately from one another, and thus there is no need, and thus no motivation or suggestion to combine, the connecting beam of Oliver with Armstrong.

For at least the reasons set forth above, it should be apparent that the rejection to claim 17 is in error, and should be withdrawn.

Applicant's claim 18 includes all the limitations of claim 17, and further provides "a first vertical support portion means attached to said mounting means so that said first vertical support portion means is generally centered widthwise on said cargo rack". This is a means-plus-function limitation that should be construed under 35 USC 112, sixth paragraph, and as such is limited to the corresponding structure in the specification and its equivalents. As noted above, Armstrong does not teach anything other than a rack that rests in the bed of a truck behind the cab of the truck, and not "centered widthwise on said cargo rack". As such, the rack of Armstrong cannot meet the limitations of claim 18.

Applicant's claim 20 includes all limitations of claims 17-19, and further provides "a single short connection means attached to said center of each said elongated middle portion support means, each said single short connection means being in facing relation, an elongated, single connection means connected at one end to said single short connection means of said the elongated middle portion support means of said rear end assembly, whereby said front end assembly and said rear end assembly are connected together and stabilized, and said elongated single connection means extends lengthwise over a middle of said vehicle". This is a means-plus-function limitation that should be construed under 35 USC 112, sixth paragraph, and as such, is limited to the corresponding structure in the specification and its equivalent. As noted above, the reference to Oliver provides a short connection stub at a front of his rack, and a sleeve that receives his beam at the rear. As such, the

reference to Oliver fails to teach all the limitations of Applicant's claim 20. In addition, the sleeve arrangement of Oliver is an adjustment mechanism for adjusting length of the rack, while Applicant's "short connection means" merely connect the "elongated connection means" to each end of the rack. Thus, the structure, function and result of the features of claim 20 are different than structure, function and result of the structure of Oliver.

Claims 22-24 are rejected in an omnibus manner, with no explanation or reasoning whatsoever to support the rejection. As noted above, this rejection is untenable and should be withdrawn.

It is further noted that claim 22 provides "mounting a first single vertical support so that said first single vertical support extends upward over a middle of a front of said vehicle, said middle being with respect to width of said vehicle, mounting a second single vertical support so that said second single vertical support extends upward over a middle of a rear of said vehicle..." and "using a connecting member, connecting said first boat-receiving member and said second boat-receiving member together, said connecting member extending over said middle of said vehicle". As noted above, the reference to Armstrong does not fairly teach, suggest or show a vertical support extending "upward over a middle of a front of said vehicle". Rather, Armstrong shows both supports in the bed of a truck behind the cab of the truck, the front of the truck being truncated. Armstrong also does not disclose Applicant's "connecting member", which as noted would cause Armstrong to be inoperable for its intended purpose, which includes folding to a stowed position. Further,

there is no discernable reason for adding to Armstrong or problem to be solved by the addition of the connecting member of Oliver. For these reasons, the rejection to claim 22 is further defective, and should be withdrawn.

Claim 5 defines the invention of claims 1-2 and 4, and further provides that the vehicle is an ATV, and is rejected over Armstrong in view of Oliver, and further in view of Toivola. This is a completely untenable combination because Armstrong cannot be modified to be mounted to a rack of an ATV because there are no side walls on an ATV to support his rack, and the lower support is a pivoting support so that the racks can be folded to a stowed position. Any modification of Armstrong's rack to be mounted to an ATV would make it unsuitable for its intended purpose, which includes folding to a stowed position, and would require significant redesign. Such redesign would include any proposed modification as taught by Toivola. In addition, as noted above with respect to claim 1, no legally identifiable reason is enumerated by the Office as to why one skilled in the art, given the references of Armstrong, Oliver and Toivola, would be led to develop Applicant's rack. Rather, the Office has assembled a catalog of prior art parts and assembled these parts into Applicant's rack using Applicant's specification and hindsight reconstruction as a guide.

Claims 6 provides the composite invention of claims 1-2, 4-5, and adds the further feature "wherein said front bottom base member and said rear bottom base member extends across a width of each said platform site...". The rejection to claim 6 suffers the same defects as the rejection to claim 5. It is

further noted that claim 6 reiterates that the “front bottom base member and said rear bottom base member extends across a width of each said platform site...”. As noted above, this feature is not found in Armstrong as he uses a clevis-type bracket that only extends a short distance along the width of the bed of the truck. For at least these reasons, the rejection to claim 6 is defective, and should be withdrawn.

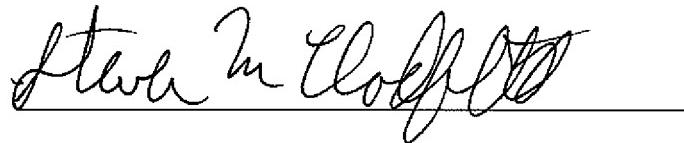
Claim 16 provide a composite invention including all the features of claims 1, 2 and 9, and adds the additional features of gear attachments positioned at least at one of “a center of each said elongated middle portion, at least one end of said front mounting base member, at least one end of said rear mounting base member, at an upper end of each said lower upright post portion”, and is rejected over the primary reference to Armstrong in view of Oliver, and further in view of Whiting. Whiting is relied on for his teaching of eyelets at each end of his boat-receiving members. While claim 16 should be allowable due to the deficiencies of the combination of Armstrong and Oliver are noted above, it is further noted that Whiting does not teach the limitations of claim 16. Here, the eyelets of Whiting, positioned at ends of his boat-receiving members, are clearly for tying down a boat or other elongate article atop his rack. In contrast, Applicant’s “gear attachments” are not positioned for attaching a boat, but rather are positioned to attach “gear”. Such “gear attachments” are in addition to Applicant’s eyelets 71 for tying down a boat. For at least these reasons, the rejection to claim 16 is untenable, and should be withdrawn.

## **CONCLUSION**

As all the rejections are believed obviated with this amendment, favorable action is respectfully requested. None of the amendments to the claims add new matter, and such amendments merely address the 35 USC 112 first paragraph rejections made by the Examiner.

Respectfully submitted,

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Steven M. Clodfelter, Reg. No. 34,564  
LANIER FORD SHAVER & PAYNE P.C.  
Customer Number 21491  
P.O. Box 2087  
Huntsville, Alabama 35804-2087  
Phone: (256) 535-1100  
Fax: (256) 533-9322